CUSTOMER NO.: 24498
Serial No.: 10/552,560
Office Action dated: September 26, 2007
Response dated: November 13, 2007

PATENT
PU030091

REMARKS

The Office Action mailed September 26, 2007 has been reviewed and carefully considered. No new matter has been added.

Claims 1-17 are pending.

Claims 1-17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0058894 to Feuerstraeter et al. (hereinafter "Feuerstraeter") in view of U.S. Patent No. 5,524,253 to Pham et al. (hereinafter "Pham"). The rejection is respectfully traversed.

It is to be noted that Claims 1, 10, and 11 are the independent claims currently pending in the instant application.

It is respectfully asserted herein that Claims 1, 10, and 11, and all of the claims that depend there from, are patentable and non-obvious over the cited references for at least three reasons as set forth herein. First, it is respectfully asserted that the rejection is deficient on it face, as the Examiner has not equated every element of the claims to a corresponding reference, as is required for a proper rejection under 35 U.S.C. 103(a). Second, it is respectfully asserted that none of the cited references, either taken singly or in combination, teach or suggest all of the recited limitations of Claims 1, 10, and 11. Third, it is respectfully asserted that even assuming arguendo that all of the recited limitations are taught, the rejection must be withdrawn because a combination of Feuerstraeter and Pham to obtain the inventions of Claims 1, 10, and 11 results in a change in the principle of operation of any of Feuerstraeter and Pham, which is a prohibition against a reference being used against a pending claim as provided in MPEP §2143.01.

With respect to the first assertion made above (i.e., the rejection is deficient on its face), the Applicants respectfully asserts that that the Examiner has only addressed the limitations of Claim 11 in his rejection of the pending independent claims with respect to equating claim limitations to (corresponding portions of) a reference. For example, in the pending Office Action, the Examiner has grouped together independent Claims 1, 10, and 11, but has only addressed the specific limitations of Claims 11, while ignoring the specific limitations of Claims 1 and 10. For example, pages 2-3 of the current Office Action state the following:

Regarding claims 1 and 10-11:

Feuerstraeter et al. disclose a router comprising:

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processor, memory, and support circuitry having a

WAN/LAN port manager (paragraph 0027 recite the processor, memory,

and support circuitry, and paragraph 0033 recite the device being auto-

configured to operate in LAN or WAN space depending upon the port

type);

a LAN interface; a WAN interface; and a plurality of physical ports

selectively connectable to said LAN interface or said WAN interface (Fig.

1 shows the LAN and WAN interfaces and ports connecting the LAN or

WAN interface), wherein

said WAN/LAN port manager controls whether each of said

plurality of physical ports is coupled to said LAN interface or said WAN

interface (paragraph 0043 recite means for controlling the deserializer

configuration for LAN or WAN).

While the Examiner has further continued his rejection of Claims 1, 10, and 11 on pages
5-7 of the pending Office Action, the rejection continued on pages 5-7 is directed to Pham and
similarly omits any correlation between the specific limitations of Claims 1 and 10 and any of
the cited references, with the exception of mentioning the message recited in Claims 1 and 10,
while completely omitting the following limitations of Claims 1 and 10:

associating, responsive to receiving said message, a set of mapping

assignments for using said physical port to access said network; and

implementing said mapping assignments, responsive to associating

said mapping assignments, to configure said physical port for coupling to said

network.

That is, the mapping assignments recited in Claims 1 and 10 are no where mentioned
with respect to any of the cited references (let alone associating and implementing the same),
except in the Examiner's reasoning for why the references should be combined. However,
without any correlation to the references as to where these specific limitations of Claims 1 and
10 are disclosed therein, the rejection is deficient on it's face, as it is well settled that "[t]o
establish prima facie obviousness of a claimed invention, all the claim limitations must be taught

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or suggested by the prior art" (MPEP §2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

With respect to the second assertion made above (i.e., none of the cited references teach or suggest all of the recited limitations of Claims 1, 10, and 11), it is respectfully asserted that none of the cited references teach or suggest the following steps/means for recited in Claims 1 and 10:

receiving a message to configure said physical port for use with said network;

associating, responsive to receiving said message, a set of mapping assignments for using said physical port to access said network; and

implementing said mapping assignments, responsive to associating said mapping assignments, to configure said physical port for coupling to said network,

wherein said implementing step selectively controls whether said physical port is coupled to the LAN interface or the WAN interface.

Further, it is respectfully asserted that none of the cited references teach or suggest "wherein said WAN/LAN port manager selectively controls whether each of said plurality of physical ports is coupled to said LAN interface or said WAN interface responsive to a configuration message", as recited in Claim 11.

For example, as noted above, the Examiner has not even correlated any portion of any of the references to the associating step/means for recited in Claims 1 and 10 nor the mapping assignments recited with respect thereto. It is to be noted that the only place the Examiner correlates the word "mapping" to any specific reference is with respect to claim 2 which recites "storing said mapping assignments". To Claim 2, the Examiner has cited paragraph [0025] of Feuerstraeter.

Paragraph [0025] of Feuerstraeter discloses the following:

Embodiments of the invention may include apparatus for performing the operations herein. These apparatuses may be specially constructed for the desired purposes, or they may comprise a general purpose-computing device

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selectively activated or reconfigured by a program stored in the device. Such

a program may be stored on a storage medium, such as, but is not limited to,

any type o disk including floppy disks, optical disk, CD-ROMs, magnetic-

optical disks, read-only memories (ROMs), random access memories (RAMs),

electrically programmable read only memories (EEPROMs), magnetic or

optical cards, or any other type of media suitable for storing electronic

instructions, and capable of being coupled to a system bus for a computing

device.

However, the Examiner's mere citation of a storage device in Feuerstraeter does not,
in any way, rise to disclosing the specific limitations relating to "associating, responsive to
receiving said message, a set of mapping assignments for using said physical port to access
said network; and implementing said mapping assignments, responsive to associating said
mapping assignments, to configure said physical port for coupling to said network", as
recited in Claims 1 and 10. Further, this first and only mention of the word "mapping" with
respect to any of the references is, as noted above, made with respect to Claim 2, and not
Claims 1 and 10, which recite significantly more elaborate limitations that simply mapping
assignments or storing the same.

Moreover, Pham does not cure the deficiencies of Feuerstraeter with respect to the
preceding limitations of Claims 1 and 10, and is silent with respect to the same.

Thus, none of the cited references teach or suggest the preceding recited limitations of
Claims 1 and 10 relating to associating and implementing the mapping assignments as
specifically recited therein.

Moreover, while Feuerstraeter is directed to a "method and apparatus for autosensing
LAN vs WAN to determine port type" (Feuerstraeter, Title), Feuerstraeter uses a data rate
detection unit to sample a **data rate** from an incoming signal to determine whether the
incoming signal has a "WAN data rate" and hence, is to be coupled to a WAN port or
whether the incoming signal has a "LAN data rate" and, hence, is to be coupled to a LAN
port. Thus, Feuerstraeter does not disclose or even NEED to use a configuration message.
That is, Feuerstraeter does not disclose or even NEED the step of/means for receiving a
message to configure said physical port for use with said network as recited in Claims 1 and
10, nor does Feuerstraeter disclose or even NEED a WAN/LAN port manager for controlling

whether each of said plurality of physical ports is coupled to said LAN interface or said WAN interface <u>responsive to a configuration message</u> as recited in Claim 11.

The receipt of the message is part of a set of **hierarchical limitations** formed in Claims 1 and 10, wherein the set of mapping assignments are <u>associated</u> **responsive to** <u>receiving the message</u>, and further wherein the mapping assignments are implemented **responsive to** <u>associating the mapping assignments</u>.

Hence, Feuerstraeter does not disclose a configuration message as recited in any of Claims 1, 10, and 11.

It is respectfully asserted that Pham does not cure the deficiencies of Feuerstraeter, and is silent with respect to the above-recited limitations of Claims 1, 10, and 11.

For example, the Examiner has cited column 2, lines 40-60 of Pham regarding the configuration message recited in the above mentioned claims.

Column 2, lines 40-60 of Pham disclose the following:

> Another example of a system for providing interprocess communication between different computer processes connected over a distributed network is the Process Activation and Message Support (PAMS) system for Digital Equipment Corp. This system generally allows processes to communicate with each other regardless of where the processes reside on **a** **common network**. Such processes may be located on a single CPU or spread across workstations, clusters, or local or wide area networks (LANs or WANs). The PAMs system manages all connections over the network and provides integration features so that processes on respective workstations, clusters and the like may communicate. In particular, the PAMs message processing system is a network layer which is implemented above other networks to transparently integrate new networks and events into a common message bus. Such a system enables network configuration to be monitored and message flow on the message bus to be monitored from a single point. The result is a common programming interface for all host environments to which the computer system is connected. Thus, all host environments appear the same to the user.

Initially, it is pointed out to the Examiner that while the preceding cited portion of Pham mentions LANs and WANs, the PAMs system is directed to communication between processes **on a common network** and, thus, only one of a LAN or a WAN would be involved, in contrast to the present invention as claimed in Claims 1, 10, and 11 which involve a device (a router) capable of concurrently interacting with both LANs and WANs as the recited router in these claims is so recited to include a LAN interface and a WAN interface and it is well know that routers are capable of concurrently communicating with both types of networks and not just one as disclosed with respect to the PAMs system. That is, while Claims 1, 10, and 11 mention a port of a router for selective coupling to a LAN or WAN, such router is clearly capable of concurrently communicating with at least two networks and is not restricted to a common network as is the PAMs system disclosed in Pham. Given this inherent and prominent feature of a router of being able to concurrently communicate with two or more networks, the messaging system of PAMs is not applicable to these limitations of Claims 1, 10, and 11 and hence, at the least, Pham does not teach a message as recited in Claims 1, 10, and 11.

With respect to the third assertion made above (i.e., the combination of Feuerstraeter and Pham to obtain the inventions of Claims 1, 10, and 11 results in a change in the principle of operation of any of Feuerstraeter and Pham, which is a prohibition against a reference being used against a pending claim as provided in MPEP §2143.01), the following text of MPEP §2143.01 is provided:

> If the proposed modification or combination of the prior art would
> change the principle of operation of the prior art invention being modified,
> then the teachings of the references are not sufficient to render the claims
> *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)
> (Claims were directed to an oil seal comprising a bore engaging portion with
> outwardly biased resilient spring fingers inserted in a resilient sealing member.
> The primary reference relied upon in a rejection based on a combination of
> references disclosed an oil seal wherein the bore engaging portion was
> reinforced by a cylindrical sheet metal casing. Patentee taught the device
> required rigidity for operation, whereas the claimed invention required
> resiliency. The court reversed the rejection holding the "suggested

combination of references would require a substantial reconstruction and

redesign of the elements shown in [the primary reference] as well as a change

in the basic principle under which the [primary reference] construction was

designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Thus, in Feuerstraeter, the principle of operation involves the use of a machine,

namely a data rate detection unit to "detect[] the port type of a remote device" (see

Feuerstraeter, Abstract). That is, as argued above, port assignments are made by detecting a

data rate to identify a LAN data rate and WAN data rate.

In contrast, the PAMs system disclosed in Pham allegedly relies upon messages.

Thus, modifying any of Feuerstraeter and/or Pham would effectively change the

principle or operation of either of these references, which is prohibited under MPEP

§2143.01.

Accordingly, a combination of Feuerstraeter and Pham is improper under MPEP

§2143.01.

"To establish prima facie obviousness of a claimed invention, all the claim limitations

must be taught or suggested by the prior art" (MPEP §2143.03, citing *In re Royka*, 490 F.2d

981, 180 USPQ 580 (CCPA 1974)). "If an independent claim is nonobvious under 35 U.S.C.

103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Accordingly, Claims 1, 10, and 11 are patentably distinct and non-obvious over the

cited references for at least the reasons set forth above.

Claims 2-9, 12, 14, and 16 depend from Claim 1 and thus include all the limitations of

Claim 1. Claims 13, 15, and 17 depend from Claim 10 and thus include all the limitations of

Claim 10. Accordingly, Claims 2-9, 12, 14, and 16 are patentably distinct and non-obvious

over the cited references for at least the reasons set forth above with respect to Claim 1, and

Claims 13, 15, and 17 are patentably distinct and non-obvious over the cited references for at

least the reasons set forth above with respect to Claim 10.

Moreover, said dependent claims include patentable subject matter in and of

themselves and are, thus, patentable distinct and non-obvious over the cited references in

their own right. For example, it is respectfully asserted that none of the cited references,

either taken singly or in combination, teach or suggest "wherein said network is a Local Area

Network (LAN) prior to said step of implementing and is a Wide Area Network (WAN) after said step of implementing", as recited in Claim 5. In support of his rejection of Claim 5, the Examiner cited paragraph [0035] of Feuerstraeter, which simply discloses that "various embodiments of the present invention deal primarily with the different port types (e.g., LAN or WAN) found at the physical layer 202". However, Claim 5 is essentially recited that a conversion has taken place in that the network previously connected to the physical port prior to configuring per said implementing step is a LAN while subsequent to configuring per said implementing step is a WAN. In contrast, the cited portion of Feuerstraeter does not disclose or even remotely imply such conversion, but rather simply suggest different port types THAT MAY BE FOUND AT THE PHYSICAL LAYER. Accordingly, Feuerstraeter does NOT disclose the above-recited limitations of Claim 5.

Moreover, it is respectfully asserted that none of the cited references teach or suggest "wherein said message is created after detecting at least one hardware switch setting change", as recited in Claim 8. The Examiner has cited paragraph [0035] of Feuerstraeter as disclosing the same. However, the hardware means disclosed in the cited section relates to "hardware means of sending and receiving data on a carrier, including defining cables, cards, and physical aspects", and there is no mention in any portion of Feuerstraeter that a message to reconfigure a port is created after detecting at least one hardware **switch** setting change. For example, a hardware **switch** is not even recited with respect to the physical layer 202 to which the hardware means applies as per paragraph [0035] of Feuerstraeter. Accordingly, Feuerstraeter does NOT disclose the above-recited limitations of Claim 8.

The Examiner is respectfully requested to re-evaluate his position with respect to Claims 5 and 8.

Thus, reconsideration of the rejections is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of September 26, 2007 be withdrawn, that pending claims 1-17 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

No fee is believed due with regard to the filing of this amendment. However, if a fee is due, please charge Deposit Account No. 07-0832.

Respectfully submitted,

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